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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/654,976

09/05/2003

Kumiko Kado

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23850 7590 02/11/2008
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EXAMINER

MCCLENDON, SANZA L

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

02/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/654,976	Applicant(s) KADO ET AL.	
	Examiner Sanza L. McClendon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on November 09, 2007, the examiner has carefully considered the amendments. Please note that the record has changed. The new examiner will be Sanza L. McClendon, art unit 1796.

Response to Arguments

2. Applicant's arguments filed November 09, 2008 have been fully considered but they are not persuasive. Applicant appears to be relying on teachings from the disclosure to distinguish the instantly claimed invention from the cited prior art of the rejections. In particular, it is argued the instant invention that the specified silica pigment-cationic resin composite fine particles when contained in an ink receiving layer exhibits high ink absorption and dispersion stability and enables the subject ink receiving layer to exhibit high ink absorption properties and a high gloss. Also enables the recorded ink images on the ink receiving layer to exhibit high water resistance, excellent resistance to wet blotting and excellent clarity comparable to that of silver salt photographic images. While applicant's invention may possess these properties unfortunately the claims are silent to these properties. Additionally, "exhibiting excellent ... properties" is a relative term which renders the claim indefinite. These terms are not defined by the claims, as well as, not having a standard for ascertaining the requisite degree.

Also, Igarashi et al, which was relied upon in the obviousness rejection teaches that the addition of the cationic polyvinyl amine properties, such as water resistance is improved and the internal bond strength deterioration is suppressed. Additionally, it is taught the water absorption degree of the recording sheet is at least 110% the printed image on said sheet is freed from smudging and staining, which as interpreted by the examiner means blotting. Therefore it is deemed that the combination of references renders applicant's instantly claimed invention obvious in view of the prior art. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Accordingly the teachings regarding smudging (see above for explanation), staining (see above for explanation), blotting (see Kitamura et al and Liu et al)—which terms (staining and smudging are being interpreted by the examiner as blotting—can be found in the references.

The rejections found in the previous office action, mailed 8/09/2007, still stands and are hereby incorporated by reference in this office action.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al (6,713,160) in view of either Igarashi et al (5,882,775) or Sato et al (5,281,340).

See office action mailed 08/09/2007 for detailed description.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al in view of Igarashi et al or Sato et al as applied to claims 10-15 above, and further in view of Nakatani et al (2002/0045034).

See office action mailed 08/09/2007 for detailed description.

6. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al (6,270,837) in view of Igarashi et al (5,882,755).

See office action mailed 08/09/2007 for detailed description.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al in view of Igarashi et al as applied to claims 10-15 above, and further in view of Nakatani et al (2002/0045034).

See office action mailed 08/09/2007 for detailed description.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/

02/01/2008

Primary Examiner

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